



**UNITED STATES DEPARTMENT OF COMMERCE
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HL

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/882,415	06/25/97	ZHANG	MIT-7762

HM12/1202
HAMILTON BROOK SMITH & REYNOLDS
TWO MILITIA DRIVE
LEXINGTON MA 02173-4799

EXAMINER
GARCIA, M

ART UNIT	PAPER NUMBER
1618	

DATE MAILED: 12/02/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.
08/882,415

Applicant(s)
Zhang et al

Examiner
Maurie E. Garcia, Ph. D.

Group Art Unit
1618



THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☐ expires _____ months from the mailing date of the final rejection.
- b) ☒ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☒ Appellant's Brief is due two months from the date of the Notice of Appeal filed on Sep 1, 1999 (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Sep 1, 1999 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- ☒ The proposed amendment(s):
- ☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
 - ☒ will not be entered because:
 - ☒ they raise new issues that would require further consideration and/or search. (See note below).
 - ☐ they raise the issue of new matter. (See note below).
 - ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: See attached.

- ☐ Applicant's response has overcome the following rejection(s):

- ☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

- ☐ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: _____

Claims objected to: _____

Claims rejected: 1-19

- ☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.

- ☒ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

- ☐ Other

ADVISORY ACTION

Attachment

The proposed amendments to the claims raise new issues under 35 USC 112, 2nd paragraph. For example, the new limitation that the support "has ordered areas wherein the peptides are bound and not bound to the solid support" is indefinite. It is unclear what applicant intends by this phrase; are the peptides both bound and not bound in the ordered areas? The phrase "substantially homogeneously distributed" is also deemed to be indefinite. The term "substantially" is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what the metes and bounds of a substantially homogeneous monolayer would be.

Furthermore, the proposed amendments do not place the application in better form for appeal by reducing or simplifying the issues. The proposed new limitations change the scope of the claims and raise new issues for consideration as described above.

**BENNETT CELSA
PRIMARY EXAMINER**

Maurie E. Garcia, Ph.D.
November 29, 1999

Bennett Celsa 12/1/99